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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Naoyuki Wada

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EXAMINER

MACE, BRAD THOMAS

ART UNIT

PAPER NUMBER

2663

3

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,759

Applicant(s)

WADA, NAOYUKI

Examiner

Brad T. Mace

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: Reference #1 should be reference #13 on line 3 of pg. 10. Reference #106 should be reference #101 on line 27 of pg. 13. "Severs" should be "servers" on line 21 of pg. 19. Appropriate correction is required.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to because "INUMBERS" should be "NUMBERS" in Figure 14A. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 11 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

6. Claim 4 is objected to because of the following informalities: the word "first" should be "second" on line 11 of pg. 22. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

.invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,052,145 ("Macrae et al.") in view of U.S. Patent No. 6,205,485 ("Kikinis").

Regarding claim 12:

9. Macrae et al. teaches a communication system (see Figure 1) in which program data is transmitted through a communication network to a client (see Figure 1, reference 18 and reference 32), the system comprising a broadcasting computer (server) (see Figure 1, reference 10), at least one client (see Figure 1, reference 32) and a set-up box (filter unit) (see Figure 1, reference 30). The set-up box (filter unit) comprising a processor for controlling the set-up box (filter unit) entirely (see Figure 3, reference 36 of reference 30, a first interface for receiving schedule data from the server (see Figure 3, top left of reference 30 and lines 5-6, col. 5), a second interface for receiving request information from the client (see Figure 3, reference 50, thus must have an interface to be received by reference 54), a filter circuit for forwarding the schedule data to be received by the client (lines 5-9, col. 5), a third interface for transmitting the schedule data forwarded by the set-up box (filter) circuit (see Figure 3, reference 56), and an analog/digital (A/D) converter for converting the schedule data received through the first interface and the set-top box (filter) circuit into a digital form (see Figure 5a, reference 74 with respect to Figure 4, reference 74 of 34, and with respect to Figure 3, 34 of 30). However, Macrae et al. does not disclose expressly that the set-up box (filter) first interface receives program data, that a set-up box (filter) circuit forwards the program

data to be received at the client, and a third interface that transmits the program data forwarded by the set-up box (filter) circuit.

Kikinis teaches a set-up box (filter) that has a first interface that receives a data stream (program data) (see Figure 1, references 120, 130, and 121, and lines 16-24, col. 4), which is supplied to the set-up box (filter) circuit that forwards the data stream (program data) to be received at the client (see Figure 2, references 153, 150, 132, and 122), and a third interface that transmits the program data forwarded by the set-up box (filter) circuit (see Figure 2, references 153, 150, 132, and 122).

A person of ordinary skill in the art would have been motivated to employ Kikinis in Macrae et al. in order to obtain a set-up box (filter) that accommodates both program data and scheduling data. The suggestion/motivation to employ Kikinis in Macrae et al. would have been to use an efficient system that utilizes a set-up box (filter) that can forward both the program data and scheduling data together to the receiver as to reduce any additional components necessary for receiving the program data alone. At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Kikinis with Macrae et al. (collectively "Macrae et al. – Kikinis") to obtain the invention as specified in claims 12 and 13.

Allowable Subject Matter

10. Claims 1-11 are allowed.

11. The following is an examiner's statement of reasons for allowance:

Claim 1 is allowable over the prior art of record since the cited references taken individually or in combination fails to disclose: "a receiving apparatus configured to transmit request information indicating which program is being viewed/listened."

Claim 4 is allowable over the prior art of record since the cited references taken individually or in combination fails to disclose: "a filter unit configured to receive the first transfer schedule table information and the second transfer schedule table information transmitted from the first transmitting/receiving apparatus, for filtering data transmitted from the first transmitting/receiving apparatus, based on the first transfer schedule table information, and for filtering data transmitted from the second transmitting/receiving apparatus to the first transmitting/receiving apparatus, based on the second transfer schedule table information."

Claim 11 is allowable over the prior art of record since the cited references taken individually or in combination fails to disclose the same material as specified above in claim 1, since claim 11 is a substantial duplicate of claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

12. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

*Murphy et al. discloses a delivery of interactive program guide data

*Eyer et al. discloses a method and apparatus for designating a preferred source to avoid duplicate programming services

*Tsukidate et al. discloses a digital broadcasting system using virtual channels

*Davis et al. discloses a system and method for generating an information display schedule for an electronic program guide

*Chaney discloses a method and apparatus for processing a conditional access program guide as for a satellite tv service

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brad T. Mace whose telephone number is (703)-306-5454. The examiner can normally be reached on M-F, with the exception of every other Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (703)-305-4798. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

btm

Brad T. Mace
Examiner
Art Unit 2663

btm
June 9, 2004



RICKY NGO
PRIMARY EXAMINER